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EXAMINER

NGUYEN BA, HOANG VU A

ART UNIT	PAPER NUMBER
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2623

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/084,756	Applicant(s) PROIDL, ADOLF	
	Examiner Hoang-Vu A. Nguyen-Ba	Art Unit 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/27/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the amendment filed March 27, 2007.
2. Claims 1-13 remain pending. Claims 1, 5 and 10 are independent claims.

Response to Amendments

3. Per Applicant's request, Claims 1-13 have been amended.
4. The objection to Claims 1-13 is withdrawn in view of Applicant's amendments to these claims to delete unnecessary numerals and abbreviations in order to improve readability of these claims.
5. The rejection of Claims 1, 2, 8, 10 and 11 under 35 U.S.C. § 112, second paragraph is withdrawn in view of Applicant's amendments to these claims.

Response to Arguments

6. The objection to the Specification is withdrawn in view Applicant's argument that 37 CFR §1.77(c) does not require the suggested arrangement of sections in the Specification.
7. Applicant's arguments in the Remarks, pp. 7-8, have been fully considered but they are not persuasive. Following is the examiner's response to Applicant's arguments.

With respect to Claim 1, Applicant has amended the claim to now recite *determining the bonus information item (BI) for the user of the recording device (1, 2) from the number of recorder identification information items (RKI) transferred during a billing period from playback devices (1, 2, 3) to the authorization device by other users of the playback device (4) and identifying the recording device (1, 2)*. Applicant indicates that Claims 5 and 10 recite similar features. Furthermore, Applicant submits that the prior art of record, i.e., WO99/03277 fails to address the need to address

an incentive for a user of the system to canvass an acquaintance or friends as a new user for the pay per view system, in order thus to increase the number of playbacks of chargeable films (Page 2, second paragraph). In order to address this need, the present invention provides means to provide incentive bonus to a specific user when that user's friend or acquaintance borrows the same DVD content for their own uses. Accordingly, WO99/03277 fails to show or teach the determining step as recited in the amended claims.

In response to Applicant's arguments, the examiner respectfully notes the following: i) the amended claims do not specifically recite Applicant's cited feature of canvassing an acquaintance or friends as a new user for the pay per view system, in order thus to increase the number of playbacks of chargeable films notwithstanding that feature is disclosed in the Specification at Page 2, second paragraph as indicated by Applicant ; ii) even, as amended, the amended claims still read on the Office's cited section of WO99/03277 (p.1, line 26 to p. 2, line 2). The method claimed in Claim 1 nowhere recites in the claim how the claimed invention can distinguish one user from another (e.g., prompting for a user's id before playing the DVD content) since the user or user's friends plays the same DVD disc with the same DVD player (e.g., *of the playback device*), which is reasonably construed to have only one id information.

Accordingly, the rejection of Claims 1-13 under 35 U.S.C. § 102(b) as being anticipated by APA/ "WO99/03277" is maintained and reproduced hereinafter for Applicant's convenience.

Specification

8. The specification is objected to because of the following minor informalities:

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections – 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejection under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-13 are rejected under 35 U.S.C. § 102(b) as being anticipated by the admitted prior art (APA) of pages 1-2 of Applicant's background. Applicant has admitted therein that document WO99/03277 published in January 21, 1999 discloses a pay-per-view system which comprises an authorization device, a set top box (e.g., communication device) and a playback device and which appears to perform the bonus determining method claimed in this instant application. Hereinafter, the Office action relies on features described at p. 1, line 6 to p. 2, line 2 of Applicant's Specification and also on those described in the disclosure of the aforementioned document for the rejection of the claims. The 102 rejection is not to be construed to be a rejection over multiple references since the description at p.1, line 10 to p. 2, line 2 is interpreted to be a summary of the features and functions of the pay-per-view system described in WO99/03277.

Claim 1

APA discloses at least:

recording a coded playback information item (CWI) (p.1, line 9, e.g., “a chargeable film is stored as coded playback information”), and recording a link information item (LI) which identifies an authorizing device authorized to grant a playback authorization for the coded playback information item (CWI) (p. 1, lines 12-15), and recording at least one recorder identification information item on a recording carrier with the aid of the recording device, the recorder identification information item identifying the recording device (p. 1, lines 19-21, e.g., “[i]f the user of the DVD unit has a valid account with the authorization device... the playback authorization for the chargeable film is then obtained...”; it is noted that in order to verify that the account is valid, the DVD unit has to send a recorder identification number stored thereon for the authorizing device to check the validity of this id number);

obtaining a playback authorization for the coded playback information item (CWI), played back with the aid of a playback device from the recording carrier or from a copy of the recording carrier, from the authorizing device identified by the link information item (LI), in order to permit a pay per view billing of a playback charge (p. 1, lines 16-25);

transferring the at least one recorder identification information item, played back from the recording carrier or from the copy of the recording carrier, to the authorizing device identified by the link information item (LI) (p. 1, lines 16-25); and

determining the bonus information item (BI) for the user of the recording device from the number of recorder identification information items transferred during a billing period to the authorizing device by other users of the playback device and

identifying the recording device (p.1, line 26 to p. 2, line 2).

Claim 5

APA discloses at least *a playback device (e.g., "DVD unit") for obtaining a playback authorization for playing back (p. 1, lines, 18-19) a coded playback information (CWI) (p. 1, line 9) recorded on a recording carrier (e.g., "DVD disk") having*

playback means (e.g., "DVD unit) for playing back the coded playback information item (CWI) and for playing back a link information item (LI) which identifies an authorizing device authorized to grant the playback authorization for the coded playback information item, and for playing back at least one recorder identification information item from the recording carrier, the recorder identification information item identifying a recording device with the aid of which the coded playback information item (CWI) was recorded on the recording carrier (p. 1, line 6 to p. 2, line 2), and having

communication means (e.g., "set top box") for establishing a communication link, identified by the link information item (LI), played back from the recording carrier, with the authorizing device, in order to obtain the playback authorization for the playback information item (CWI) played back from the recording carrier, the communication means being designed for transferring the at least one recorder identification information item, played back from the recording carrier, to the authorizing device (p. 1, line 6 to p. 2, line 2), and for providing a bonus information item (BI) for a user of the playback device from the number of recorder identification information items transferred during a billing period to the authorizing device by other users of the playback device (p.1, line 26 to p. 2, line 2).

Claim 10

APA discloses, at least at p. 1, line 6 to p. 2, line 2, *an authorizing device (p. 1, line 7) for granting a playback authorization for playing back a coded playback*

information item (CWI) with the aid of a playback device, and for determining a bonus information item (BI) (p.1, line 26 to p. 2, line 2) for a user of a recording device, having communication means (e.g., "set top box") for receiving a playback authorization inquiry information item (AFI) (p. 1, lines 16-25; as discussed in the rejection of claim 1, this feature is deemed inherent to the process of checking the validity of the account described at p. 1, lines 19-21), which identifies the playback device and a coded playback information item (CWI) provided by the playback device for playing back from the recording carrier, and which includes a recorder identification information item, the recorder identification information item identifying the recording device with the aid of which the coded playback information item (CWI) provided for playing back was recorded on the recording carrier, and having

authorizing means for checking whether a successful pay per view billing of a playback charge is warranted for the user of the playback device and, in the event of a positive checking result, for billing the playback charge for playing back the coded playback information item (CWI), and for outputting a grant of playback authorization information item (WBI) to the playback device, and having bonus information determining means for determining the bonus information item (BI) for the user of the recording device from the number of recorder identification information items transferred during a billing period to the authorizing device by other users of the playback device and identifying the recording device (p.1, line 10 to p.2, line 2).

Claims 2, 6 and 11

APA further discloses a recorder identification information item transferred to the authorizing device from the playback device when the playback authorization is obtained is only rated for determining the bonus information item (BI) for the user of the recording device

when the authorizing device has actually also granted the playback authorization for this playback device (p.1, line 16 to p. 2, line 2).

Claims 3, 7 and 13

APA further discloses the link information item (LI) represents an Internet address of the authorizing device, and in which both the obtaining of the playback authorization from the authorizing device, and the transferring of the recorder identification information item to the authorizing device are performed via data lines of the Internet (NET) (p.1, lines 13-15).

Claims 4 and 12

APA further discloses the authorizing device stores user data for billing the playback charge to the user together with at least one recorder identification information item which identifies a recording device and/or playback device of the user (p. 1, line 26 to p. 2, line 2; it is noted that in order to allow specific users of the system a quantity rebate, user data for billing has to be stored on the database of the authorizing device).

Claim 8

APA further discloses the playback means are designed for playing back all those recorder identification information items recorded on the recording carrier, which identify all those recording devices which have contributed to creating the copy of the recording carrier played back by the playback device, and in which the communication means are designed for transferring all the recorder identification information items, played back from the recording carrier, to the authorizing device (WO99/03277, FIG. 1, items 2, e.g., DVHS video

recorder and 3, e.g., DVD recorder; each has its own identification information).

Claim 9

APA further discloses *recording means are provided which are designed for recording on the recording carrier the coded playback information item (CWI), the link information item (LI) and the recorder identification information item identifying the playback device* (WO99/03277, FIG. 1, items 2, e.g., DVHS video recorder and 3, e.g., DVD recorder; each has its own identification information).

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection (e.g., rejection of Claim 5) presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.¹²

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang-Vu "Antony" Nguyen-Ba whose telephone

number is (571) 272-3701. The examiner can normally be reached on Tuesday-Friday from 7:00 am to 5:30 pm.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, John Miller can be reached at (571) 272-7353.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2600 Group receptionist (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



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June 9, 2007